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| 09/809,922   | 03/16/2001  | William L. Thomas    | ODS-38                        | 7120               |
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| FISH & NEAVE<br>1251 AVENUE OF THE AMERICAS<br>50TH FLOOR<br>NEW YORK, NY 10020-1105 |             |                      |                               |                    |
|  |             |                      | EXAMINER<br>ASHBURN, STEVEN L |                    |
|  |             |                      | ART UNIT<br>3714              | PAPER NUMBER<br>14 |

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/809,922

Applicant(s)

THOMAS, WILLIAM L.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION******Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Dec. 24, 2003 has been entered.

***Claim Rejections - 35 USC § 103***

**Claims 1, 11, 33 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al, GB 2,147,773 A (May 15, 1985) in view of Sarno, US 6,024,641 (Feb. 15, 2000).**

Dickinson discloses an interactive lottery system using user equipment that teaches (a) providing a listing of lotteries in which the user can participate on a display and (b) giving the user the ability to participate in at least one of the lotteries. *See fig. 1, 6-9B; pp. 1:24-29, 10:48-11:50*. Dickinson teaches all the features of the claims except using user equipment. The examiner interprets "user equipment" to mean equipment that is the possession of player (e.g. owned or leased) rather than owned or operated by game vendor.

Sarno teaches that it is known in the art to offer lottery games on user equipment. *See col. 1:7-2:5*. In view of Sarno, it would be obvious to an artisan to modify the lottery gaming device disclosed by Dickinson to add the feature of using user equipment. As suggested by Sarno allowing players to participate in lotteries from their homes using user equipment offers several benefits including (i) increasing lottery revenues by allowing participation by remotely located players, (ii) providing lotteries access to players who cannot afford to travel to jurisdictions that allow lotteries, (iii) enhancing convenience and ease of access, and (iv) offering the potential for enormous winnings. *See id.*

**Claims 1-7, 9, 11-17, 19, 33 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scagnelli et al., U.S. Patent 5,921,865 (Jul. 13, 1999) in view of Fraser et al., U.S. Patent 5,329,589 (Jul. 12, 1994), in further view of LottoBot, (Feb. 1999), downloaded from the Internet website <http://web.archive.org/web/19991128172018/http://lottobot.net/> on Feb. 25, 2004.**

Claims 1, 11, 33 and 49: Scagnelli discloses an interactive lottery system using user equipment that (a) provides a listing of lotteries in which the user can participate on a display and (b) gives users the ability to participate in at least one lotteries using the user equipment. *See fig. 3(b)(c), 5a.* However, because it relies a telephone as an user interface, Scagnelli does not disclose visually displaying the lottery listings. Fraser discloses methods for mediating transactions over telecommunications systems. In particular, it teaches replacing telephones with terminals displaying visual prompts instead of voice prompts. *See col. 13:15-31.* In view of Fraser, it would have been obvious to modify the lottery system disclosed by Scagnelli, wherein a telephone audibly lists lotteries in which a user can participate, to add the feature of visually displaying the lottery listings on terminal. As suggested by Fraser, the modification would enhance the system by provides prompts visually using a terminal display rather than relying on voice prompts. *See id.*

Claims 2, 12, 34 and 50: As discussed above, the lottery system suggested by Scagnelli in view of Fraser describes all the features of the claim except notifying the user that the results to a lottery are available. *LottoBot* discloses an analogous lottery system allowing users to access lottery data over the Internet through the user's computer. In particular, the system notifies users that lottery results in which the user participated are available. *See p. 1.* In view of *LottoBot*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lottery system suggested by Scagnelli in view of Fraser, wherein remotely located users participate in lotteries through over a network, to add the

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feature of notifying the users that their lottery results are available. As taught in *LottoBot*, the modification would enhance the lottery system by allowing users who participate in one or more lotteries to be automatically informed of the results and thereby provide a more convenient system by reducing the attention required of the user. *See p. 20.*

Claims 3, 13, 35 and 51: *LottoBot* additionally teaches transmitting notification as a computer email or pager message. *See p. 1.* Telephone messages, pop-up overlay messages and icons are equivalent methods known in the art for the same purpose as emails and pager messaging for indicating a message data on electronic devices.

Claims 4, 14, 36 and 52: *LottoBot* additionally teaches displaying the results to at least one of the lotteries in which the user participated. *See p. 1.*

Claims 5, 15, 37 and 53: *LottoBot* additionally teaches indicating whether the user won for each of the lotteries for which the user participated. *See p. 1, 20.*

Claims 7, 17, 39 and 55: *LottoBot* additionally teaches reminding the user of an upcoming lottery drawing associated with at least one of the lotteries in which the user participated. *See pp. 1 (e.g. jackpot alerts).*

Claims 9, 19, 41 and 57: *LottoBot* teaches displaying a user interface to the user for use in creating a lottery wager, wherein the user interface is customized for each one of the lotteries. In particular, the reference displays a separate display for each lottery and type. *See p. 4.*

**Claims 6, 16, 38 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scagnelli in view of Fraser, as applied to claims 2, 12, 34 and 50 above, in further view of Luciano et al., U.S Patent 6,168,521 (Jan. 2, 2001).**

The lottery system suggested by the Scagnelli in view of Fraser teaches all the features of the instant claims except a multimedia recording of the lottery drawings associated with the lotteries in which the user participated. Regardless of the deficiency, this feature would have been obvious to an artisan in view of *Luciano*.

*Luciano* discloses an analogous electronic lottery game system utilizing multiple player-activated video terminals that are linked to computers. *See abstract*. Each player places a wager and selects his lottery draw choices and the system enrolls the player in a future lottery game after the player makes his choices. *See id*. After automatically drawing lottery numbers, the system displays the result of the selected game displayed at the player's terminal in such a manner as to provide the excitement of a real time game. *See abstract; fig. 9; 1:21-58; 8:21-58*. The player can at anytime activate a stored replay of the drawing game. *See fig. 6(627); col. 8:12-20*. In view of *Luciano*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify The lottery system suggested by the Scagnelli in view of Fraser to add the feature of recording of the lottery drawings associated with the lotteries in which the user participated. As suggested by Scagnelli, recording the results of a lottery drawing enhances the entertainment provided to players by offering the excitement of a real time game and allowing players to replay the game at any time. *See abstract; fig. 9; 1:21-58, 8:10-58*.

The lottery system suggested by the Scagnelli in view of Fraser and *Luciano* describes a lottery game offering at least a video recording of a drawing. However, none of the references explicitly describe recording audio in combination with the video. Hence, the combination of references do not necessarily describe recording the lottery drawings in a multimedia format. Regardless, at the time of the invention it was notoriously well known in the art to display game results using multimedia combinations

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of audio and video to enhance to entertainment of games by stimulating more than one of the players senses. Consequently, it would have been obvious to an artisan at the time of the invention to modify the lottery system suggested by the Scagnelli in view of Fraser and Luciano, wherein lottery results are recorded as video, to instead record multimedia combinations of audio and video and thereby to enhance to entertainment of games by stimulating more than one of the players senses

**Claims 8, 18, 40 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scagnelli in view of Fraser, as applied to claims 2, 12, 34 and 50 above, in further view of *SGI Insights*, Scientific Gaming International, vol. 1, issue no. 5 (Jan. 1999).**

The lottery system suggested by Scagnelli in view of Fraser describes all the features of the claims except giving the user the ability to generate lottery gift certificates. SGI Insights teaches that it is known to give users the ability to order lottery gift certificates. *See p. 4*. In view of SGI Insight, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Scagnelli, wherein users generate lottery entries over a telecommunication link, to add the feature of giving the user the ability to generate lottery gift certificates. As suggested in SGI Insight, lottery gift certificates are very popular amongst users. *See id.* Thus offering them to users would enhance the operator's revenues by increase purchases through the system.

**Claims 10, 20, 42 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scagnelli in view of Fraser, as applied to claims 1 and 11 above, in further view of McCollom et al., U.S. Patent Application Publication 2002/001623 A1 (Jan. 24, 2002).**

The lottery system suggested by Scagnelli in view of Fraser describes all the features of the claims except giving the user the ability to finalize a wager at a later time and reminding the user to finalize the wager. Regardless of the deficiencies, these features would have been obvious to an artisan.

McCollom teaches an analogous system allowing users the purchase items and coupons over the Internet wherein users are given the ability to finalize a purchase at a later time and reminded the user to finalize the purchase. In particular, the reference allows to place purchases in a “shopping basket” or “wish list” for later purchase. *See fig. 13, 14, 17*. The system’s display provides an indication reminding the user that the purchase is not finalized. *See fig. 21, 22; p. 8, ¶ 0107*.

In view of McCollom, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lottery system suggested by Scagnelli in view of Fraser, wherein users purchase lottery tickets over the Internet, to add the features of giving the user the ability to finalize a wager at a later time and reminding the user to finalize the wager. As taught by McCollom, the modification would improve the system by allowing users to browse, assemble and store wagers until the time the elect to make a purchase. *See p.10, ¶¶ 0132-0137*.

**Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. 6,325,716 B1 (Dec. 4, 2001) in view of Archer, U.S. 6,277,026 B1 (Aug. 21, 2001)**

Claims 21, 27, 43 and 59: Walker discloses the claimed features of giving the user the ability to set conditions via user equipment on which an interactive wagering application is partially implemented and automatically participating in the lottery on the behalf of the user when the conditions have been met. *See col. 2:36-3:35*. However, Walker does not describe the electronic user equipment. Instead, Walker employs paper tickets.

Archer teaches an analogous system for selling lottery tickets online via user equipment. *See fig. 1, 4A; col. 5:10-15*. In view of Archer, it would have been obvious to an artisan at the time of the



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invention to modify Walker, wherein users submit lottery entries using paper tickets, to instead use electronic user equipment. As suggested by Archer, the modification facilitate the sale and distribution of lottery tickets by enabling online sale and distribution and thereby enhance revenues. *See col. 1:36-67.*

Claims 22, 28, 44 and 60: Walker discloses automatically participating in the lottery comprises using a default set of lottery numbers. *See col. 3:1-8, 5:1-19.*

Claims 23, 29, 45 and 61: Walker discloses default sets of lottery numbers are user-specified. *See id.*

Claims 24, 30, 45 and 61: Walker discloses automatically participating in the lottery comprises using a set of randomly generated lottery numbers. *See id.*

Claims 25, 31, 46 and 62: Walker discloses conditions based on factors selected from the group consisting of a period of time from the last time the user participated, the lottery prize, the odds of winning and any combination thereof. *See col. 2:54-3:1; 4:11-27.* In regards, to the odds of winning, the reference teaches enrolling a ticket based on a minimum payout, which determines the ticket's expected payout (i.e. odds of winning a particular payout).

Claims 26, 32, 47 and 63: Walker discloses automatically participating in the lottery on behalf of the user every time the lottery is offered. *See col. 1:55-64, 2:54-64.*

***Prior Art, Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- a. Amazon.com (Oct. 1999), downloaded from <http://web.archive.org/web/-199911013091817/http://amazon.com> on Feb. 26, 2004. This reference describes the format of well known online retailer at a time prior to the invention. The site provides demonstrates many features claimed by the applicant that were within the ordinary knowledge of online retailers at the time of the invention.
- b. WO 97/09699 (Mar. 13, 1997) to Brenner et al. discloses an analogous gaming system allowing players to record the outcome selection event in a multimedia format. *See, e.g., pp. 4:7-13, 62:14-28*

***Response to Arguments***

Applicant's arguments with respect to claims 1-64 have been considered but are moot in view of the new grounds of rejection. Responses to selected arguments are provided below in order to clarify the examiner's position.

Regarding claims 6, 16, 38 and 54, the applicant argues that Luciano does not describe recording the lottery drawings associated with the lotteries in which the user participated. The examiner respectfully disagrees. Luciano teaches storing (i.e. recording) several different game plays and that a player can replay the outcome of his lottery draw. *See col. 8:40-57*. These pre-stored game plays are clearly "associated" with the lottery in which a user participated. Hence, Luciano meets the limitations of the claims.

The applicant argues further that the recording may be, for example, an audio-visual recording of a live lottery. In response it is noted that the features upon which applicant relies (i.e., recording live event) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hence, the argument is not persuasive. Notably, the examiner concedes that neither Scagnelli nor Luciano discloses recording of actual, live events. Luciano is limited to pre-recorded events.

The applicant argues further the prior art does not suggest recording the lottery drawings in a multimedia format. The examiner respectfully disagrees. Luciano describes storing recordings of drawing in, at least, a video format to provide an entertaining display. See *col. 1:44-63, 8:40-57*. The examiner maintains that it would have been within the ordinary skill of an artisan to include in the recording audio and thereby provide a multimedia display of the lottery drawing.

Regarding claims 10, 20, 42 and 58: In response to applicant's argument that McCullom is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, the claims are directed to a system for executing purchases using a computer. Although a particular problem is not stated in the applicant's disclosure, the features are directed toward ensuring that users are able complete a purchase after navigating their way through a computer's user-interface. The claimed invention solves this problem by allowing users who begin the process of making purchases the ability to later finalize their purchases and by reminding users to finalize their purchases.

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In comparison, McCollom discloses an analogous system for executing purchases using a computer. It solves the problem of ensuring that users complete the steps required to make purchase after interacting with the computer's user-interface by giving users the ability to later finalize their purchases and by reminding the users to finalize their purchases. *See fig. 13, 14, 17, 21, 22; p. 8, ¶ 0107.* Hence, McCollom is analogous art because it is directed to the particular problem with which the applicant is concerned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



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PRIMARY EXAMINER